



GP/1652

PATENT
ATTORNEY DOCKET NO. DIVER1180-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robertson et al.
Serial No.: 09/382,242
Filed: August 24, 1999
Title: ESTERASES

Art Unit: 1652
Examiner R. Prouty

RECEIVED

Commissioner for Patents
Washington, D.C. 20231

MAR 21 2001

TRANSMITTAL SHEET

TECH CENTER 1600/2900

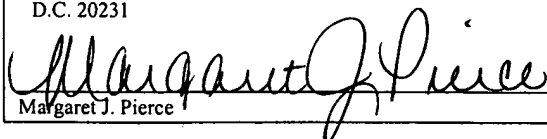
Sir:

Transmitted herewith please find the following:

- (1) Response to Species Election; and
- (2) Return postcard.

CERTIFICATION UNDER 37 CFR §1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on 3-12-01, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231


Margaret J. Pierce

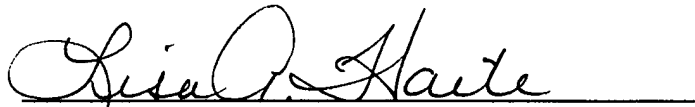
In re Application of:
Robertson et al.
Application No.: 09/382,242
Filed: August 24, 1999
Page 2

PATENT
Attorney Docket No.: DIVER1180-1

No fee is deemed necessary in connection with the filing of this paper. However, if any fee is required, authorization is hereby given to charge the amount of any such fee, or credit any overpayment, to Deposit Account No. 50-1355.

Respectfully submitted,

Date: 3/12/01



Lisa A. Haile, Ph.D.

Reg. No. 38,347

Direct Line: (858) 677-1456

Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
USPTO Customer Number 28213
4365 Executive Drive, Suite 1600
San Diego, CA 92121-2189



PATENT
ATTORNEY DOCKET NO. DIVER1180-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robertson et al.
Serial No.: 09/382,242
Filed: August 24, 1999
Title: ESTERASES

Art Unit: 1652
Examiner R. Prouty

#8
D.Q.
3/23/01

Commissioner for Patents
Washington, D.C. 20231

RECEIVED

MAR 21 2001

TECH CENTER 1600/2900

RESPONSE TO SPECIES ELECTION

Sir:

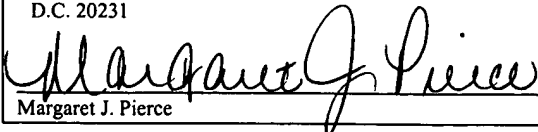
In response to the Restriction Requirement mailed February 12, 2001, Applicants elect the sequence of SEQ ID NO: 23 with traverse and respectfully request rejoinder of at least SEQ ID Nos:23-32, which are all nucleic acid sequences that encode proteins having esterase activity.

The Examiner is respectfully directed to MPEP §803.04 "Restriction - Nucleotide Sequences" and 37 CFR 1.141(a), which set forth the requirements and the examination of more than one nucleotide sequence directed to possible distinct polypeptide sequences. MPEP §803.04 states in part,

"[T]o further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided sua sponte to partially waive the requirements of 37 CFR 1.141 et seq. and permit a reasonable

CERTIFICATION UNDER 37 CFR §1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on 3-12-01, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231


Margaret J. Pierce

In re Application of:

Robertson et al.

Application No.: 09/382,242

Filed: August 24, 1999

Page 2

number of such nucleotide sequences to be claimed in a single application. See Examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996). It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten **independent** and **distinct** nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together. In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten. In other cases, applicants may petition pursuant to 37 CFR 1.181 for examination of additional nucleotide sequences by providing evidence that the different nucleotide sequences do not cover independent and distinct inventions.

(Emphasis Added).

As described in the present specification SEQ ID NOs: 23-32 share common functional characteristics-they all encode esterases. Applicants respectfully point out that searching all of these sequences would not unduly burden the Examiner because the sequences could be searched and then similar art could be searched for functional similarity. In addition, according to MPEP §803.04, "up to ten independent and distinct nucleotide sequences will be examined." Applicants submit that sequences corresponding to SEQ ID Nos: 23-32 are ten sequences which have a high degree of at least functional identity, and satisfy the requirements of MPEP §803.04. Thus, examination of these sequences together is requested in accordance with MPEP §803.04.

In order to be fully responsive to the Restriction Requirement, Applicants elect, with traverse, SEQ ID NO:23, drawn to a species of nucleic acid encoding an esterase from *Staphylothermus marinus*.

In re Application of:
Robertson et al.
Application No.: 09/382,242
Filed: August 24, 1999
Page 3

PATENT
Attorney Docket No.: DIVER1180-1

If it appears that a telephone conference would helpfully advance prosecution, please
telephone the undersigned at (858) 677-1456.

Respectfully submitted,

Date: 3/12/01



Lisa A. Haile, Ph.D.
Registration No. 38,347
Telephone: (858) 677-1456
Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
USPTO Customer Number 28213
4365 Executive Drive, Suite 1600
San Diego, CA 92121-2189